REMARKS

Applicant has carefully reviewed the Office Action mailed June 16, 2004, and offers the following remarks to accompany the above amendments.

Applicant herein amends claim 8 to change the term "host" to "host computing device" so the term is consistent throughout the claims. This amendment does not change the scope of the claim, but avoids any ambiguity in what was meant by "host." No new matter is added.

Claims 1, 8, and 19 were provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that claims in co-pending application 09/803,291. Applicant respectfully traverses. A same invention type double patenting rejection is appropriate when each of the claims has the same limitations. A difference in scope is sufficient to make a same invention type rejection inappropriate. The Patent Office opined that claim 1 of the present application was the same as the claim 1 of the '291 application. Applicant notes that claim 1 of the '291 application recites an interface frame associated with the portable device on a display of the host computing device. This element is not present in claim 1 of the current application. Because claim 1 of the '291 application recites an element which is not present in claim 1 of the present application, the claims have differing scopes, and it is inappropriate to reject the present application as being directed to the same invention. Applicant requests withdrawal of the § 101 rejection of claim 1 at this time.

The Patent Office opined that claim 8 was the same as claim 11 of the '291 application. As claim 8 of the present application depends from claim 1 and claim 11 of the '291 application depends from its respective claim 1 and the respective claims 1 have differing scopes, claims 8 and 11 have differing scopes. Since the claims have differing scopes, they do not claim the same invention, and a § 101 rejection is improper. Applicant requests withdrawal of the § 101 rejection of claim 8 at this time.

The Patent Office opined that claim 19 was the same as claim 17 of the '291 application. Applicant notes that claim 17 of the '291 application recites an interface frame. Claim 19 of the present application does not recite the interface frame. Because claim 17 of the '291 application recites an element which is not present in claim 19 of the present application, the claims have differing scopes, and it is inappropriate to reject the present application as being directed to the same invention. Applicant requests withdrawal of the § 101 rejection of claim 19 at this time.

8

Claim 14 was rejected under 35 U.S.C. § 102(e) as being anticipated by Guthery. Applicant respectfully traverses. For the Patent Office to prove anticipation the Patent Office must provide a reference that shows all the claim elements. Further, the elements of the reference must be arranged as claimed. MPEP § 2131.

Claim 14 recites software that stores select information associated with the computing session in the memory (of the portable device) instead of on the computing device, wherein the host computing device would normally store the select information on the host computing device when the portable device is not present. The Patent Office opines that this element is taught in Guthery, col. 5, lines 1-58. Applicant traverses this assertion. The cited passage indicates that the IC card may have certain resources thereon including tickets, travel reservations, medical prescriptions, and the like; however, there is no indication that these would normally be stored on the host computer when the portable device is not present as recited in the claim. Likewise, the host computing device is described as having applications thereon that access the resources on the IC card, but there is no indication that the select information is stored in the memory of the portable device when present, but would normally be stored on the host computing device. Since the recited claim element is not taught or suggested, the claim is not anticipated and the rejection is improper. Applicant requests withdrawal of the § 102(e) rejection of claim 14 at this time.

If the Patent Office disagrees, Applicant requests that the Patent Office identify with greater particularity what element in the cited passage is being construed to be the recited software that stores select information in the memory of the portable computing device wherein the select information would normally be stored on the host computing device when the portable device is not present. In the absence of a better explanation, the reference does not show the claim element, and the rejection is improper.

Claims 1-13 and 15-27 were rejected under 35 U.S.C. § 103 as being unpatentable over De la Huerga (hereinafter "Huerga") in view of Guthery. Applicant respectfully traverses. For the Patent Office to establish obviousness over a combination of references, the Patent Office must first make a valid combination. To make a valid combination, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the references. Second, the Patent Office must provide actual evidence to support the motivation. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Further, to establish *prima facie* obviousness,

9

once the combination has been made, the combination must teach or suggest all the claim elements. MPEP § 2143.03. If the Patent Office cannot show all the claim elements, then Applicant is entitled to a patent.

Applicant initially notes that this rejection does not list claims 28-32, although these claims are addressed within the body of the text underneath this heading. Applicant proceeds as if these claims were listed in the rejection. If another rejection was intended for claims 28-32, Applicant requests clarification and an additional opportunity to respond thereto.

Applicant traverses the combination of Huerga and Guthery. On page 4 of the Office Action, the Patent Office opines that the combination is obvious because it would free memory that was in the system for storage of other information and allow the user to use any terminal. Applicant traverses this motivation because it is not supported by the actual evidence that the Federal Circuit mandates be provided to support motivations. Applicant notes that the Patent Office provides an alternate motivation to combine the references on page 7 of the Office Action (in the section relating to claim 11), stating it would have been obvious because ports are interfaces between computers and other devices and therefore can be used to send data to and from the computer and the device. Again, this motivation lacks the required actual evidence. The Patent Office provides one additional motivation on page 7 (in the section relating to claims 13 and 31), stating that it would be obvious to combine the references because it would simplify coordination between the device and the terminal. Again, this motivation lacks the requisite actual evidence. Since the Patent Office has not substantiated any of the proffered motivations, the motivations are improper. Since the motivations are improper, the combination is improper. Since the combination is improper, and the references individually do not teach or suggest all the claim elements, the Patent Office has not established obviousness, and the claims are allowable.

Applicant further traverses the motivations as non-compelling. Specifically, the combination does not satisfy the first motivation in that if the host computing device does not have an IC reader, the use of the portable body with the memory thereon does not allow the user to use any terminal. Likewise, and perhaps more importantly, shifting the security badge of Huerga to the IC card of Guthery means that the IC card would not work with the wireless transmitters of the hospital described in Huerga. To this extent, the first motivation fails on face to suggest the combination. The second motivation is likewise non-compelling. Huerga allows the security badge to send data to and from the computer and the device, namely, the

10

authorization data that is solicited through Huerga's interrogation. Since Huerga inherently satisfies the second motivation, there is no reason to add Guthery to Huerga and the motivation does not suggest the combination. Likewise, the third motivation is not satisfied by the combination. There is no evidence that the keylets simplify communication. In fact, the software would have to be changed to accommodate such keylets, thereby increasing the complexity of the system. To this extent, the motivation is non-compelling, and the combination is improper. Since the motivations are non-compelling, the combinations are improper, and the references individually do not teach or suggest all the claim elements, the Patent Office has not established obviousness, and the claims are allowable.

Applicant still further traverses the combination as rendering Huerga unsuitable for its intended purpose. That is, Huerga states that a purpose is to use a device that is worn by the user (see Huerga, col. 1, lines 15-17). Modification to an IC/smart card according to Guthery renders the device unsuitable for wearing and thus unsuitable for Huerga's stated purpose. It is improper, in an obviousness analysis, to make a combination that renders a device unsuitable for its intended purpose. MPEP § 2143.01. Applicant also notes that Huerga specifically criticizes the use of user access cards (see Huerga, col. 1, line 66-col. 2, line 6). It is improper to make a combination when one of the references teaches away from the combination. MPEP § 2141.02. Because Huerga criticizes usage of user access cards, modification from Huerga's security badge to an IC/smart card is improper. Since the combination is improper either because Huerga teaches away from the combination or because the combination renders Huerga unsuitable for its intended purpose (or both), and the references individually do not teach or suggest all the claim elements, the Patent Office has not established obviousness, and the claims are allowable.

Even if the combination is proper, a point which Applicant does not concede, the combination still does not establish *prima facie* obviousness, and the claims are allowable.

Claim 1 recites that the software on the portable computing device instructs the host computing device to remove records pertaining to the computing session. The Patent Office opines that this element is taught at Huerga, col. 5, lines 11-25. Applicant traverses this assertion. While the cited passage does indicate that the user is automatically logged off in the event of an interruption in the communication between the computer terminal and the security badge, the automatic deletion of files that have been cached is done by software on the computer terminal, not by software on the portable device as recited in the claims. The addition of

11

Guthery does not cure this deficiency. Since the combination of references does not teach that the software on the portable device instructs the host computing device to remove records, the Patent Office has not established *prima facie* obviousness, and the claim is allowable. Claims 2-13 depend from claim 1 and are patentable at least for the same reasons.

Claim 15, depends from claim 14, which was rejected under just Guthery alone. The Patent Office, in its rejection of claim 15 relies on Huerga combined with Guthery. However, the Patent Office does not provide an analysis of how the elements of claim 14 are shown by the combination of Huerga and Guthery. Regardless, claim 15, like claim 1, recites that the software of the portable device is adapted to instruct the host computing device to remove records. As explained above, the combination of references does not teach or suggest this element, and the claim is allowable. Claim 16 depends from claim 15 and is patentable at least for the same reasons. Claims 17 and 18 depend from claim 14 and are patentable at least for the same reasons that claim 14 is patentable.

Claim 19, like claim 1, recites software on the portable computing device, instructing the host computing device to remove records. As explained above, the combination of references does not teach or suggest this element, and the claim is allowable. Claims 20-26 depend from claim 19 and are patentable at least for the same reasons.

Claim 27, like claim 1, recites that the software of the portable computing device executes so as to instruct the host computing device to remove records. As explained above, the combination of references does not teach or suggest this element, and the claim is allowable. Claims 28-32 depend from claim 27 and are patentable at least for the same reasons.

Applicant requests reconsideration of the rejections in light of the remarks presented herein. The references of record, either alone or in combination, do not teach or suggest that the software on the portable computing device instructs the host computing device to remove records. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

12

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:

Benjamin S. Withrow
Registration No. 40,876
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520

Date: August 24, 2004
Attorney Docket: 4989-008

CERTIFICATE OF TRANSMISSION
I HEREBY CERTIFY THAT THIS DOCUMENT IS
BEING TRANSMITTED VIA FACSIMILE ON
THE DATE INDICATED BELOW TO:

Examiner: Klimach, Paula W.   Art Unit: 2135
Fax: 703-872-9306

Name of Sender

Signature

8/24/04
Date of Transmission

13